UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/729,302 | 12/04/2000 | David R. Hansen | H10125/JDP | 7605 |

1333 7590 12/21/2007

EASTMAN KODAK COMPANY
PATENT LEGAL STAFF
343 STATE STREET
ROCHESTER, NY 14650-2201

| EXAMINER | |
|---|---|
| THOMPSON, JAMES A | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2625 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 12/21/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

---

*Ex parte* DAVID R. HANSEN

---

Appeal 2007-1990
Application 09/729,302
Technology Center 2600

---

Decided: December 21, 2007

---

*Before* JAMES D. THOMAS, ALLEN R. MACDONALD, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals a Final Rejection of claims 40-63 under 35 U.S.C. § 134. We have jurisdiction under 35 U.S.C. § 6(b).

According to Appellant, Appellant invented a method and system for displaying a graphical user interface that permits a print operator to assign group identifiers into a document to establish groups of pages in a document

and instruct a computer to print one or more groups of pages of the document. (Spec. 17:9-23.)

Claim 40 is exemplary and is reproduced below:

> 40. A method of operating a print system to print an electronically formatted document having a plurality of pages comprising running a Print Document Management System (PDMS) program on a computer which receives the document into the Print Document Management System program; and displays in the PDMS a Graphical User Interface ("GUI") which permits a print operator to assign group identifiers into the document to establish groups of pages in the document to thereby create an amended document and instruct the computer to send one or more of the groups of pages of the amended document to an output data stream for printing.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

| | | |
|---|---|---|
| Motoyama | US 5,353,388 | Oct. 4, 1994 |
| Hanson et al. | US 5,956,736 | Sep. 21, 1999 |
| Rourke et al. | US 5,995,721 | Nov. 30, 1999 |
| Kato | US 5,978,557 | Nov. 2, 1999 |

Claims 40, 42-43, 46, 48-50, 52, 54-55, 58, and 60-62 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings and suggestions of Motoyama and Hanson.

Claims 41, 44, 47, 53, 56, and 59 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings and suggestions of Motoyama, Hanson, and Rourke.

Claims 45 and 57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings and suggestions of Motoyama, Hanson, and well-known prior art.

Claims 51 and 63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings and suggestions of Motoyama, Hanson, and Kato.

We affirm.

## FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

*Motoyama*

1. Motoyama teaches a "printer control methodology, using a 'Page Description Language' (PDL) was developed to control laser printers. Various PDL's were developed in the 1980s, the best known examples being PostScript (a trademark of Adobe Systems Incorporated) and Interpress, although a number of proprietary PDL's are used by different printers. These prior art PDLs introduced many useful printer control methodologies, including such tools as Resource Declarations, Context Declarations, Dictionaries, the use of memory stacks, as well as a large number of predefined commands for defining specific graphical image elements, for controlling the contents of the printer controller's memory, and so on." (Col. 1, ll. 24-37.)

2. Motoyama teaches "a document 100 used by the present invention is represented by a set of page description language (PDL) elements which are divided into page sets, and pictures. Both page sets and pictures can have prologue sections that define structural elements of the document, and these prologue sections are organized in a hierarchical fashion so that the declarations and definitions in each prologue are *applicable only to the subset of the document* that is subtended by that prologue." (Emphasis added) (Col. 3, ll. 49-58.)
3. Motoyama teaches a prologue of a document includes a document production instruction "doc_prod_inst_decl." (Col. 4, l. 59-61.) Motoyama teaches "Document Production Instructions 232 define things such as the number of copies of each page that are to be printed." (Col. 8, ll. 50-52.) Motoyama teaches "[d]ocument production instructions" include an "instruction to *print only pages 7 through 10* of a document are handled initially by the document production instruction manager 310 so as to store the appropriate production control values in data structure 232 (see FIG. 4). Thereafter, the document structure manager 300 uses the stored document production control values to *skip over* or discard *sections of the document corresponding to unselected portions of the document*." (Emphasis added) (Col. 10, ll. 29-37.)
4. Motoyama teaches "Imaging Driver Module 206 runs in parallel with the other modules of the image processor. As imaging parameters are

written into data structure 228, the Imaging Driver Module 206 picks them up and processes them, either building up bit map images until a page is ready to be printed, or printing individual elements as they arrive." (Col. 11, ll. 37-43 and Fig. 8.)

*Hanson*

5. Hanson teaches a graphical user interface that permits creation and editing of HTML documents. (Col. 7, ll. 38-42.)

*Additional Prior Art Cited by the Board*

6. We cite the following prior art: Working with Microsoft Word 6.0: Part II: The Art of Page Design, At The Office, Vol. 6, Issue 5 (May 1995) (available at www.smartcomputing.com) (hereafter "MS Word").
7. MS Word is prior art under 35 U.S.C. § 102(b).

*MS Word*

8. MS Word teaches a graphical user interface that permits character and paragraph formatting. (Fig. 1.)
9. MS Word teaches "[t]o divide your document into sections, position the insertion point where you want to begin a section." (P. 4, ll. 30-31.)

PRINCIPLES OF LAW

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of

nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls."). The Court in *Graham* further noted that evidence of secondary considerations, such as commercial success, long felt but unsolved needs, failure of others, etc., "might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." 383 U.S. at 18. "If a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid under § 103." *KSR*, 127 S. Ct. at 1734.

The Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248

[(1850)]." *KSR,* 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)), and reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The operative question in this "functional approach" is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740. "[W]hen a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious." *Id.* at 1740 (citing *Sakraida v. AG Pro, Inc.*, 425 U. S. 273, 282 (1976)).

"Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* at 1742. The Court noted that "[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id.* "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *Id.*

In *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), although the combination of prior art references lacked a "reader" to automatically identify the book inserted in the device, the Federal Circuit found no error in the District Court's determination that

readers were well known in the art at the time of the invention. The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* (citing *KSR*, 127 S. Ct. at 1740-41).

## ANALYSIS

### Claim 40

The Examiner finds that a combination of Motoyama and Hanson teaches all elements of claim 40. (Answer 3-5 and 14-18.) Appellant alleges that Motoyama does not teach a GUI that permits a print operator to assign group identifiers into a document to establish groups of pages in the document. (App. Br. 4.) Moreover, Appellant alleges that "Appellant has not found any teaching or suggestion in the Motoyama patent that the application program 190 receives a PDL document and then subsequently modifies it or amends it by assigning group identifiers into the document." (Reply Br. 8.) In addition, Appellant alleges that Hanson does not teach a creating step where a Print Document Management System permits "assign group identifiers into the document to establish groups of pages in the document to thereby create an amended document." (App. Br. 4.)

Appellant also alleges that Motoyama does not teach an instructing step that comprises "instruct the computer to send one or more of the groups of pages of the amended document to an output data stream for printing"

because the instructing step requires "sending portions of an amended document based upon the groups of pages established by the group identifiers." (Reply Br. 8.)

Therefore the issues are whether the Appellant has shown that the Examiner erred by finding that the combined teachings of Motoyama and Hanson teach (1) using a GUI in the creating step and (2) the instructing step.

*Using a GUI in the Creating Step*

Motoyama teaches a print management system that prints portions of a document in response to commands embedded in the document that specify the portions to print. (FF 3.) Hanson teaches a GUI that permits creating and editing of an HTML document. (FF 5.) The combination of Motoyama and Hanson does not teach using a GUI to establish groups of pages and thus the combination does not teach using a GUI in the creating step. However, MS Word teaches that it was well known in the art at the time the invention was made to provide a GUI that permits a user to edit an existing document to define different portions of a document (e.g., one or more paragraphs) as sections. (FF 9.)

Motoyama suggests incorporation of a document editor to permit editing documents to have desired attributes by teaching of the availability of Page Description Language (PDL) that can be used to create documents with embedded commands. (FF 1-3.) Thus, Motoyama provides reason to

incorporate MS Word's GUI into Motoyama's system in order to provide a user with a capability to edit documents to establish groups of pages in the document.

In addition, incorporating MS Word's GUI into Motoyama's print management system neither changes the function of the GUI nor the print management system. *See KSR,* 127 S. Ct. at 1740. Incorporating MS Word's GUI into Motoyama's system yields an expected result of allowing a user to establish groups of pages in a document and print pages in a group.

A combination of MS Word's GUI and Motoyama's print management system teaches a print management system having a GUI that permits assigning groups in a document to create an amended document. Appellant has done nothing more than use known techniques for their intended purpose to achieve an entirely expected result.

Accordingly, we will sustain the Examiner's rejection for the reasons as set forth above as we find that the prior art renders obvious the creating step.

*Instructing Step*

We next address whether the combined teachings of Motoyama and Hanson teach the instructing step. The instructing step requires printing pages of an amended document that includes group identifiers. We find the instructing step is taught by Motoyama's Document Production Instructions 232, which are *embedded* in a document and specify which portions of a

document to print (FF 3). Accordingly, we conclude that Appellant has not shown that the Examiner erred in rejecting claim 40 under 35 U.S.C. § 103(a).

Claims 42-43, 46, 48-50, 52, 54-55, 58, and 60-62

Claims in this group are subject to the same rejection as claim 40. Appellant has not presented any separate substantive arguments directed to the separate patentability of claims in this group, but relies instead on arguments for patentability of claim 40. (App. Br. 3-5.) Therefore, as to the rejection of the claims in this group, Appellant has not shown Examiner error for the same reasons discussed *supra* with respect to claim 40.

Claims 41, 44, 47, 53, 56, and 59

Appellant alleges that Rourke does not teach or suggest a PDMS which permits a print operator to assign group identifiers into a document to establish groups of pages in the document. (App. Br. 6.) However, the Examiner does not rely on Rourke to teach such features. (Ans. 3-4.)

The Examiner provides reasons in Hanson and in Rourke to combine the teachings of Motoyama, Hanson, and Rourke. (Ans. 5 and 8-11.) In a pre-*KSR* brief, Appellant alleges that the Examiner has improperly combined the teachings of the references because the prior art fails to provide any suggestion or motivation for the modification or combination of references. (App. Br. 5-6.)

Therefore the sole issue with respect to this group of claims is whether Appellant has shown that the Examiner erred by combining the teachings of Motoyama, Hanson, and Rourke.

Because Appellant does not separately argue any claim in this group, we select claim 41 as the sole claim on which to decide the issue.

Appellant's allegation that the Examiner provides no suggestion or motivation in the prior art to combine the references (App. Br. 5-6) is insufficient because the Examiner has identified reasons in both Hanson and Rourke that lead to the combination and arrives at claim 41 (Ans. 4-5, 8-9, 14-16, and 19-20). Moreover, *KSR* forecloses Appellant's arguments that a specific teaching in the prior art is required to make a combination. *See KSR*, 127 S. Ct. at 1742. In addition, combining the teachings of Motoyama, Hanson, and Rourke to arrive at a GUI that permits a print operator to instruct a computer to send multiple groups of pages simultaneously is proper because the combination would not have changed the functions of any of the combined teachings and would have yielded no more than expected results. *Id.* at 1740.

Moreover, Appellant has presented no evidence that making the combination was uniquely challenging or difficult for one of ordinary skill in the art nor has Appellant presented evidence that this incorporation represented an unobvious step over the prior art. *See Leapfrog*, 485 F.3d at 1162. Therefore, we conclude that Appellant has not shown the Examiner erred in rejecting claims 41, 44, 47, 53, 56, and 59 under 35 U.S.C. § 103(a).

Claims 45 and 57

The Examiner provides reasons for incorporating a well-known dialog box into the combined teachings of Motoyama and Hanson and finds the combination is proper. (Answer 12 and 21.) In a pre-*KSR* brief, Appellant alleges that the references fail to provide a reason, suggestion, or motivation to combine the teachings of Motoyama, Hanson, and well-known prior art. (App. Br. 6-7.)

We found *supra* that Appellant has not shown that the Examiner erred in combining the teachings of Motoyama with those of Hanson. Therefore the sole issue with respect to this group of claims is whether Appellant has shown that the Examiner erred by combining the teachings of a well-known dialog box with those of the proper combination of Motoyama and Hanson.

Because Appellant does not separately argue any claim in this group, we select claim 45 of this group as the sole claim to decide the issue.

*KSR* forecloses Appellant's arguments that a specific teaching in the prior art is required to make a combination. *See KSR*, 127 S. Ct. at 1742. Thus, Appellant has not identified any error in Examiner's proffered reasons for combining the teachings of a well-known dialog box with those of the proper combination of Motoyama and Hanson to arrive at the claim 45.

In addition, combining the teachings of Motoyama, Hanson, and a well-known dialog box to arrive at receiving group identifiers in a dialog box is proper because the proffered combination would not have changed the

functions of any of the combined teachings and would have yielded no more than expected results. *Id.* at 1740.

Moreover, Appellant has presented no evidence that making the combination was uniquely challenging or difficult for one of ordinary skill in the art nor has Appellant presented evidence that this incorporation represented an unobvious step over the prior art. *See Leapfrog*, 485 F.3d at 1162. Therefore, we conclude that Appellant has not shown the Examiner erred in rejecting claims 45 and 57 under 35 U.S.C. § 103(a).

Claims 51 and 63[1]

Appellant alleges that Kato does not teach or suggest a PDMS which permits a print operator to assign group identifiers into a document to establish groups of pages in the document. (App. Br. 8.) However, the Examiner relies on Motoyama rather than Rourke to teach such features. (Ans. 3-4.)

The Examiner provides reasons in Kato to combine the teachings of Motoyama, Hanson, and Kato and finds the combination is proper. (Ans. 13 and 22.) Appellant alleges that the cited references fail to suggest any motivation or desirability to modify or combine the references. (App. Br. 7-8.)

[1] We note that Appellant has referenced claims 45 and 57 (App. Br. 7) but refers to claims 51 and 63 in a heading. We address claims 51 and 63 in this appeal.

Therefore the sole issue with respect to this group of claims is whether Appellant has shown that the Examiner erred by combining the teachings of Kato with the proper combination of Motoyama and Hanson.

Because Appellant does not separately argue any claim in this group, we select claim 51 of this group as the sole claim to decide the issue.

Appellant's allegation that the Examiner provides no suggestion or motivation in the prior art to combine the references (App. Br. 7-8) is insufficient because the Examiner has identified a reason in Kato that leads to the combination and arrives at claim 51 (Ans. 13 and 22). In addition, combining the teachings of Kato, Motoyama, and Hanson to arrive at replacing pages not in a group of pages with a media insertion command is proper because the combination would not have changed the functions of any of the combined teachings and would have yielded no more than expected results. *See KSR,* 127 S. Ct. at 1740.

Moreover, Appellant has presented no evidence that making the combination was uniquely challenging or difficult for one of ordinary skill in the art nor has Appellant presented evidence that this incorporation represented an unobvious step over the prior art. *See Leapfrog*, 485 F.3d at 1162. Therefore, we conclude that Appellant has not shown the Examiner erred in rejecting claims 51 and 63 under 35 U.S.C. § 103(a).

NEW GROUNDS OF REJECTION

We designate part of our affirmation (claims 40, 42-43, 46, 48-50, 52, 54-55, 58, and 60-62), which includes newly cited prior art as a new ground of rejection under 37 C.F.R. § 41.50(b)(1).

37 C.F.R. § 41.50(b) provides that, "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of appeal as to the rejected claims:

> (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner …
>
> (2) *Request rehearing*. Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record …

Should the Appellant elect to prosecute claims 40, 42-43, 46, 48-50, 52, 54-55, 58, and 60-62 further before the Examiner pursuant to 37 C.F.R. § 41.50 (b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection of claims 41, 44, 45, 47, 51, 53, 56, 57, 59, and 63, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere

incident to the limited prosecution, the affirmed rejection of claims 41, 44, 45, 47, 51, 53, 56, 57, 59, and 63 is overcome.

If the Appellant elects further prosecution before the Examiner and further prosecution does not result in allowance of the application, abandonment or a second appeal, this application should be returned to the Board of Patent Appeals and Interferences for entry of a final decision with respect to the affirmed rejection of claims 41, 44, 45, 47, 51, 53, 56, 57, 59, and 63, including any action on any timely request for reconsideration thereof.

## CONCLUSION OF LAW

(1) Appellant has not shown that the Examiner erred in rejecting claims 40-63 as unpatentable under 35 U.S.C. § 103(a).

(2) Claims 40-63 are not patentable.

## DECISION

The Examiner's rejection of claims 40-63 under 35 U.S.C. § 103(a) is affirmed.

New grounds of rejection have been entered under 37 C.F.R. § 41.50(b).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

37 C.F.R. § 41.50(b)

rwk

EASTMAN KODAK COMPANY
PATENT LEGAL STAFF
343 STATE STREET
ROCHESTER NY 14650-2201